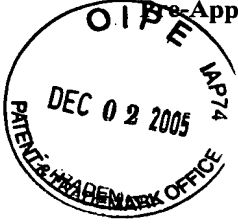DOCKET NO.: MSFT-0179/150657.1
Pre-Appeal Brief Request for Review

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Abburi

Confirmation No.: **7451**

Application No.: **09/671,643**
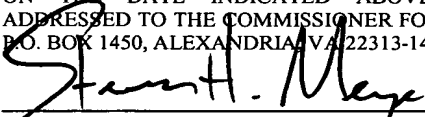
Group Art Unit: **3621**

Filing Date: **September 28, 2000**

Examiner: **Greene, Daniel L.**

For: **Retail Transactions Involving Distributed Digital Content In A Digital Rights Management (DRM) System**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request review of the final rejection in the above-identified application.

No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reasons stated on the attached sheets. No more than five pages are provided.

REMARKS – REASON FOR REVIEW

Claims 82, 85, 86, 88, 89, and 91-97 are pending in the present application and have been finally rejected. Claims 82 and 96 are independent. Applicant requests review of the final rejection of the above-identified application, consistent with the remarks previously submitted and based on the clear errors in the Final Office Action as summarized below.

The Examiner has finally rejected claims 82, 85, 86, 88, 89, 91, 93, 96, and 97 under 35 USC § 103(a) as being obvious over Schull (U.S. Patent No. 6,266,654) in view of Koppelman et al. (U.S. Patent No. 6,662,164) [Final Office Action mailed August 30, 2005, page 4 et seq.]. In addition, the Examiner has rejected claim 92 under § 103(a) as being obvious over the Schull and Koppelman references and further in view of Krishnan et al. (U.S. Patent No. 6,073,124) [Final Office Action, page 10] , and has rejected claims 94 and 95 under § 103(a) as being obvious over the Schull and Koppelman references and further in view of Powell (U.S. Patent Disclosure No. 2001/0032189) [Final Office Action, page 11 et seq.]. Applicant has respectfully traversed the § 103(a) rejections [Reply mailed October 20, 2005, page 5].

Independent claims 82 and 96 as amended recite a method of issuing digital licenses [plural] from a licensor for a corresponding piece of digital content, where the content was originally issued by a retailer. In each recited method, a plurality of transactions are performed.

Applicant respectfully submits that the Examiner has committed clear error by improperly interpreting the method recited in claims 82 and 96. According to the Examiner, the 'performing a plurality of transactions' language is in the preamble and therefore is not given any patentable weight. [Final Office Action, paragraph spanning pages 4-5].

However, Applicant has respectfully pointed out that such language is not in fact in the

preamble. In particular, the beginning clause of claims 82 and 96 is reproduced here:

> A method of issuing digital licenses from a licensor for a corresponding piece
> of digital content, the content originally having been issued by a retailer, **the method
> comprising** performing a plurality of transactions, each transaction comprising:

and the bolded 'the method comprising' clearly demarcates the transition between the

preamble beforehand and the body of the claim thereafter. Thus, it is to be appreciated that

the italicized 'performing a plurality of transactions' language is not in the preamble but is in

fact in the body of claims 82 and 96 and therefore is to be given patentable weight as a

required step of the recited method. [Reply, page 6]

Based on such improper interpretation of the method recited in claims 82 and

96, then, the Examiner has committed a clear error in the Final Office Action and for that

reason the finality of the Office Action should be withdrawn and the claims should be

examined based on a proper interpretation of the methods recited in claims 82 and 96.

Claims 82 and 96 as amended recite a method where, in addition to

performing a plurality of transactions, portions of payments are provided to a first customer

based on an accumulated count, as recited in the last clause of the claim.

Independent claim 82 as amended in particular recites that as part of

'performing a plurality of transactions', and for each transaction, the licensor receives a **first**

license request for a **first** license from a **first** customer in connection with the content, where

the **first** customer has received a copy of the content from the retailer. The **first** request

includes retailer information associated with the corresponding piece of digital content and

identifying the retailer. The licensor receives a payment from the **first** customer in

connection with the **first** license request, retrieves the retailer information from the **first**

license request and identifies the retailer therefrom, and credits the identified retailer for a

portion of the payment received in connection with the **first** license request.

Each transaction then continues with a **second** customer. In particular, after

dealing with the **first** customer, the licensor then receives a **second** license request for a

second license from a **second** customer in connection with the content, where the **second**

customer received a copy of the content from the **first** customer. The **second** request

includes **first** customer information associated with the corresponding piece of digital content

and identifying the **first** customer. The licensor receives a payment from the **second**

customer in connection with the **second** license request, retrieves the **first** customer

information from the license request and identifies the **first** customer therefrom, and credits

the **first** customer for a portion of the payment received in connection with the **second**

license request. To summarize, then, each transaction requires responding to a pair of license

requests, one from the **first** customer and one from the **second** customer.

Claim 82 also recites that crediting the **first** customer during each transaction

comprises recording the **first** customer information in a centralized database for accounting

purposes. The database includes an entry for each **first** customer information, where each

entry includes a count for counting the number of times a license has been issued for the

specific **first** customer information combination. In particular, such recording comprises

finding the **first** customer information entry in the database corresponding to the **first**

customer information of the **second** request, or creating such sub-entry if none is present, and

incrementing the count in such entry.

Thus, over the plurality of the transactions, the count in the entry is

accumulated. Accordingly, and again, in the method, and as a separate main step from the

'performing a plurality of transactions' main step, the portions of the payments are provided

to the **first** customer based on the accumulated count. **As can be seen by the numerous**

bolded 'first' and 'second' modifiers, the claim relies in part on the distinction between

a first customer and a second customer, on the distinction between a first license and a

second license, and also on the distinction between a first license request and a second

license request.

Independent claim 96 as amended recites substantially the same subject matter

as claim 82, albeit with a single first customer making the first and second license requests.

Applicant respectfully submits that the Examiner has committed clear error by

again improperly interpreting the method recited in claims 82 and 96. According to the

Examiner, the modifiers 'first' and 'second' are non-descriptive and non-functional and are

not functionally involved in the steps recited, and thus are to be ignored. [Final Office

Action, bottom half of paragraph spanning pages 3-4]. However, Applicant has respectfully

pointed out that such language cannot in fact be ignored. In particular, such modifiers are

highly descriptive, functional, and functionally involved in giving structure to the method

recited in claims 82 and 96 inasmuch as such modifiers highlight and specifically point out

two distinct customers, two distinct licenses, and two distinct license requests.

Clearly, removing such modifiers from claims 82 and 96, as the Examiner

would do, would result in such claims being nonsensical and impossible to clearly

understand. Thus, such modifiers are crucial and cannot be ignored. As its own

lexicographer, Applicant has chosen to employ the aforementioned modifiers in the manner

chosen, and the Examiner cannot casually ignore such modifiers, or any other claim language

for that matter. Instead, the Examiner must consider that such modifiers are employed for a
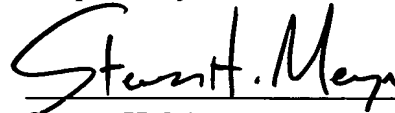
reason, and must accord an appropriate weight to such modifiers based thereon. [Reply, pages 3-5].

Based on such additional improper interpretation of the method recited in claims 82 and 96, then, the Examiner has committed a clear error in the Final Office Action and for that reason the finality of the Office Action should be withdrawn and the claims should be examined based on a proper interpretation of the methods recited in claims 82 and 96.

Thus , for all the reasons set forth above, Applicants respectfully request reconsideration and withdrawal of the final rejection of all claims, and also respectfully request examination of the claims based on a proper interpretation of the methods recited therein.

Respectfully submitted,

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